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EXAMINER

PATEL, ASHOKKUMAR B

ART UNIT PAPER NUMBER

2154

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,975

Applicant(s)

MORAN, THOMAS

Examiner

Ashok B. Patel

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2006 and 11 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-31 are subject to examination.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/30/2006 has been entered.

3. **Examiner's note:** Examiner would like to thank the Applicant for providing the clarification on the claims limitations, in the response dated 11/16/ 2005, by stating "Applicant has therefore amended the term "associated with said user" to replace it by the term "specific to said user" (emphasis added) at all occurrences throughout the claims as currently pending in this application. This amendment clarifies that the pre-specified message that is stored at the messaging server and that is to be sent from the messaging server to a destination party mail box in response to a user input is a message that is specific to that user and, by inference, not specific to other users. The pre-specified message is made specific to the user by virtue of the fact that the user creates the message for storage on the messaging server by way of pre-recording the message at the user's mail box. Basis for this amendment is found at page 2, lines 19 to 21."

Response to Arguments

4. Applicant's arguments filed 03/30/2006 have been fully considered but they are not persuasive for the following reasons:

Applicant's argument:

“ the present Invention includes “A standard message is described as being a message that may contain the originator's details and a request to be called back, by way of one example. The pre-specified standard messages are also disclosed as being recorded by the user for use in different situations. It is respectfully submitted that one skilled in the art would readily understand the scope of the term “standard” as employed in the term “pre-specified standard message” within the context of messaging systems as being a message which contains basic information which best represents the user's situation at the time the user selects the message for sending to a destination party's mailbox.”

“It is clear, however, from Lung that the recorded message or messages whether prepared by the user and/or received from other users are messages that are specific to the content of the email and that are intended to enhance the particular content of the email, i.e. the recorded messages are not specific to the user. Also, the recorded messages cannot be considered as being standard form messages since their content is directly related to the content of the email. Further, Lung neither discloses nor suggests any means by which a user can select which recorded messages in a user's attachment area are to be combined with the email.”

Examiner's response:

First of all, examiner would like to reiterate of what the Applicant considers teachings of the reference Lung as follows, as stated in this response from the Applicant:

“2. Lung teaches a method of recording a mixed-media message using an integrated messaging server. A user uses a telephone set to record a message such as a voice message which is stored in an attachment area (memory storage area for that user) of the messaging server. Subsequently, when the user sends an email message from a desk top computer, for example, the messaging system determines whether there are any recorded messages in the user's attachment area and, if so, combines the email message and the recorded message to form a mixed media message to be sent to a third party. Thus, the email message comprises the user input that triggers the system to combine the email message and any user recorded messages. There may be more than one recorded message in the user's attachment area and some of such messages may have been previously provided to the user by other users by way of email attachments, for example.”

Applicant has defined, as underlined above in Applicant's argument, as being “The pre-specified standard messages are also disclosed as being recorded by the user for use in different situations.”

Thus, according the Applicant, Ling does teach “The pre-specified standard messages are also disclosed as being recorded by the user for use in different situations.”

Now referring to Lung, Lung teaches at col. 7, line 36-44," In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (a directory or file), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630."

Also, Lung clearly states at col. 8, line 13-14, "Memory storage 510 preferably stores these files into the "attachment" area specified by the user, step 615.

Thus, Lung's user's "attachment area" is "a directory" or "files" containing more than one messages.

Lung further reveals at col. 8, line 53-62, "In alternative embodiments of the present invention, only one voice message attachment is provided, for example a PCM format message. In another embodiment of the present invention, the voice message files need not have been created by the user, the audio attachment file may be originally created by another user. For example, the user may transfer a voice-mail message she previously received into her attachment area. In such a case, the user may then create an e-mail message with text having the voice-mail message as an attachment."

Thus, Lung provides the user "selection" from the pre-specified standard messages to be sent to the destination party mail box from the messaging server.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Lung et al. (hereinafter Lung)(US 6, 532, 230 B1).

Referring to claim 1,

Lung teaches a messaging system arranged to allow a user to send a pre-specified message to a destination party mail box (Fig. 4), said messaging system comprising a communications network comprising:-

a) a messaging server arranged to store a pre-specified message specific to said user (Fig. 4, element 535, col. 7, line 32-36, "Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message, step 610.");

b) an input to the communications network arranged to receive a user input from said user; and

c) a destination party mail box; wherein when a specified user input is received from said user at the input, the pre-specified message is sent to the destination party mail box from the messaging server. (col. 7, line 36-44," In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (a directory or file), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630.")

Referring to claim 2,

Lung teaches a messaging system as claimed in claim 1 wherein said input comprises a terminal connected to the communications network and comprising a user interface.

(Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

Referring to claim 3,

Lung teaches a messaging system as claimed in claim 2 wherein the terminal is connected to the messaging server via a communications network node being a private branch exchange. (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38).

Referring to claim 4,

Lung teaches a messaging system as claimed in claim 1 wherein the messaging server comprises a processor arranged to append information received from a user of the pre-specified message. (Fig. 4, element 440, col. 7, line 1-12)

Referring to claim 5,

Lung teaches a messaging system as claimed in claim 1 wherein the messaging server comprises a processor arranged to append information received from a user to the pre-specified message to create a combined message such that in use the messaging server is later able to separate the appended information from the combined message. (col. 7, line 32-44, Figs. 9 and 10)

Referring to claim 6,

Lung teaches a messaging system as claimed in claim 5 wherein the processor is arranged to create the combined message such that, in use, when the combined message is displayed to a user the appended information is displayed as part of the pre-specified message. (col. 7, line 32-44, Figs. 9 and 10)

Referring to claim 7,

Lung teaches a messaging system as claimed in claim 1, wherein the messaging server is a multimedia messaging server.(Fig.4, element 535)

Referring to claim 8,

Lung teaches a messaging system as claimed in claim 1 wherein the destination party mail box is located on a second messaging server. (Fig.11)

Referring to claim 9,

Lung teaches a messaging system as claimed in claim 3 wherein the communications network node is arranged to route the additional information to the messaging server together with one or more control signals that are arranged to indicate that the additional information is to be appended to a pre-specified message. (col. 8, line 53-62)

Referring to claim 10,

Lung teaches a messaging system as claimed in claim 1 wherein the pre-specified message is stored in a mail box on the messaging server, said mail box being associated with the user. (Fig.11)

Referring to claim 11,

Lung teaches a method of sending a pre-specified message specific to a user, from said user to a destination party mail box in a communications network (Fig. 4), said method comprising the steps of:-

- (i) storing said pre-specified message at a messaging server in the communications network (Fig.4, element 535, col. 7, line 32-36);
- (ii) receiving an input from said user, said input indicating that the pre-specified message is to be sent to the destination party mail box ; and
- (iii) sending the pre-specified message from the messaging server to the destination party mail box. (col. 7, line 36-44)

Referring to claim 12,

Lung teaches a method as claimed in claim 11 wherein the input is received via a terminal. (Fig. 4, element "DESKTOP COMPUTER", col. 6, line 30-32)

Referring to claim 13,

Lung teaches a method as claimed in claim 12 which further comprises setting up a call between the terminal and the messaging server and receiving information from the user via this call, to be appended to the pre-specified message.(col. 9, line 49-52)

Referring to claim 14,

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Lung teaches a method as claimed in claim 13 wherein the call is routed via a communications network node between the terminal and the messaging server and wherein that communications network node is arranged to send a control signal to the messaging server, indicating that the received information is to be appended to the pre-specified message. (col. 9, line 49-52, Fig. 4, Fig.11, (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38)

Referring to claims 15,

Lung teaches a messaging server for sending a pre-specified message specific to a user, from said user to a destination party mail box in a communications network (Fig. 4, element 408, and Fig. 11), said messaging server comprising:

- (i) a store containing the pre-specified message (Fig. 4, element 510);
- (ii) an input arranged to receive information from said user, said information indicating that the pre-specified message is to be sent to the destination party mail box (Fig.4, elements 535 and 520, col. 7, line 36-44);
- (iii) a processor arranged to send the pre-specified message to the destination party mail box (Fig.4, element 440).

Referring to claim 16,

Lung teaches a communications network comprising a destination party mail box and a messaging server for sending a pre-specified message specific to a user, from said user to the destination party mail box (Figs. 4 and 11), said messaging server (Fig.4, element 408) comprising:

(i) a store containing the pre-specified message specific to said user (Fig. 4, element 510);

(ii) an input arranged to receive information from said user, said information indicating that the pre-specified message is to be sent to the destination party mail box (col. 7, line 36-44); and

(iii) a processor arranged to send the pre-specified message to the destination party mail box. (Fig.4, element 440).

Referring to claim 17,

Claim 17 is a claim to a computer program that carries out the method steps of claim 15. Therefore, claim 17 is rejected for the reasons set forth for the claim 15.

Referring to claim 18,

Lung teaches a communications signal arranged to be routed between a terminal and a messaging server, said communications signal comprising information associated with a user and a control signal which indicates that the information is to be appended to a pre-specified message at the messaging server, said pre-specified message being specific to said user.(Fig.5)

Referring to claim 19,

Lung teaches a communications network node arranged to be connected between a terminal and a messaging server, said communications network node comprising a processor arranged to set up a call between the terminal and the messaging server and to route information specific to a user from the terminal to the messaging server using this call, wherein the processor is further arranged to send a control signal with the

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routed information, said control signal indicating that the routed information is to be appended to a pre-specified message at the message server, said pre-specified message being associated with said user. (Fig. 2, element "CO", col. 1, line 18-25, col. 5, line 33-46, Fig.11, col. 10, line 25-38, col. 7, line 32-44).

Referring to claim 20,

Lung teaches a messaging system arranged to allow a user to send a pre-specified message to a destination party mail box(Fig. 4),, said messaging system comprising a communications network comprising:

a) a messaging server arranged to store a pre-specified message(Fig. 4, element 535, col. 7, line 32-36,"Initially a user uses a telephone handset to dial a predetermined "attachment" feature code, step 600 preferably an extension number as will be explained below. Next, typically in response to a voice prompt, the user records a voice message, step 610.");

b) an input to the communications network arranged to receive a user input from said user; and

c) a destination party mail box; wherein when a specified user input is received from said user at the input, the pre-specified message is sent to the destination party mail box from the messaging server (col. 7, line 36-44," In a preferred embodiment of the present invention, the system digitizes the voice message and places the recorded message in an "attachment" area (a directory or file), associated with the user, step 615. Then when the user sends an e-mail message to the system, the system determines whether there is a recorded message in the "attachment" area associated

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with the user, step 620. If so, the system forms a mixed-media message by combining the e-mail message and the recorded message, step 630.”);

wherein the messaging system further comprises a processor arranged to append spoken information received from the user to the pre-specified message prior to it being sent to the destination party mail box. (Fig.5, col. 10, line 49-52,” An e-mail message may also be text alone, text and an image, an image alone, a presentation with images, text and audio narration or accompaniment, or any other data converted for transmittal via an electronic mail system.”

Referring to claim 21,

Lung teaches a messaging system as claimed in claim 20 wherein said input comprises a user terminal connected to the communications network and comprising a user interface. (Fig. 4, element “DESKTOP COMPUTER”, col. 6, line 30-32)

Referring to claim 22,

Lung teaches a messaging system as claimed in claim 21 wherein, in response to a further user input, said processor is arranged to establish a call between the user terminal and the messaging system to receive from said user the spoken information to be appended to the pre-specified message. (.col. 9, line 49-52)

Referring to claim 23,

Lung teaches a messaging system as claimed in claim 20 wherein the processor is arranged to append the spoken information received from the user to the pre-specified message to create a combined message such that the messaging server is later able to

separate the appended spoken information from the combined message. (col. 9, line 49-52, col. 7, line 32-44, Figs. 9 and 10)

Referring to claim 24,

Lung teaches a messaging system as claimed in claim 20 wherein the pre-specified message is stored in a mail box on the messaging server, said mail box being associated with the user. (Fig.11)

Referring to claim 25,

Claim 25 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 20. Therefore claim 25 is rejected for the reasons set forth for claim 20.

Referring to claim 26,

Claim 26 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 21. Therefore claim 26 is rejected for the reasons set forth for claim 21.

Referring to claim 27,

Claim 27 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 22. Therefore claim 27 is rejected for the reasons set forth for claim 22.

Referring to claim 28,

Claim 28 is a claim to a method of sending a pre-specified message from a user to a destination party mail box in a communications network incorporated by the system of 23. Therefore claim 28 is rejected for the reasons set forth for claim 23.

Referring to claim 29,

Claim 29 is a claim to a messaging server that carries out the method of claim 25. Therefore claim 29 is rejected for the reasons set forth for claim 25.

Referring to claim 30,

Claim 30 is a claim to communications network incorporating the system of claim 20. Therefore claim 30 is rejected for the reasons set forth for claim 20.

Referring to claim 31,

Claim 31 is a claim to computer program stored on a computer readable medium, said computer program being for controlling a messaging server of claim 29. Therefore claim 31 is rejected for the reasons set forth for claim 29.

Prior Art not relied upon:

Please refer to the reference Berthoud et al. (US 7, 054, 428) listed in the attached PT0-892 which are not relied upon for claim rejections since these references are relevant to the claimed invention.

Berthoud et al. teaches at col. 3, line 28-col. 4, line 50, "Given the scenario depicted in FIG. 2, the caller at telephone 32 would conventionally be provided with a busy signal when attempting to call the Internet user's telephone 12. However, in accordance with the principles of the present invention, the caller 32 is provided with an ability to notify the Internet user of their attempted telephone call through the Internet. Moreover, in one embodiment, the appropriate central office in the PSTN 22 can detect the presence of data communications on the telephone line 107 attempted to be called, and audibly notify the caller at telephone 32 with a canned message. The central office may be provided with sufficient information to, upon request by the caller, call the called party's ISP 109 and request that an appropriate notification message be sent to the Internet user's user interface device, e.g., display 18.

To receive and act on such request for an appropriate notification message to be sent to a particular subscriber to the ISP 109, the ISP 109 includes an Internet communication module 28, and a textual or audible message recorder/IP formatter 30.

The Internet communication module 28 receives requests for notification messages from would-be callers (or an appropriate central office), and prompts the caller for input relating to the identity of the Internet user. For instance, upon receipt of a telephone call from the would-be caller to send the notification message, the Internet communication module 28 causes an audible prompt for a unique identifying number of the Internet user, which the caller inputs using the keypad of their telephone 32. Appropriate identifying numbers include a telephone number of the Internet user, or a personal identity

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number (PIN) specifically assigned to the Internet user. Alphanumeric identifying numbers are possible, but limited to the uniqueness provided by the standard 12-key touch tone keypad.

Upon identification of the appropriate Internet user to the Internet communication module 28 at the ISP 109, the caller may be provided with the opportunity to select from a plurality of possible notification messages, e.g., using keypad input. Alternatively, a standard notification message can be formed using call related information regarding the caller (e.g., Caller ID type information such as telephone number and/or household or business name) and sent as a text message to the Internet user.

The notification message may be a text message and/or an appropriately digitized audible message, e.g., in the form of a ".wav" file. The notification message may be communicated to the Internet user using conventional forms of communication, e.g., using e-mail, or may be communicated to the Internet user via a localized communication means, e.g., using a chat room provided by a particular ISP 109. When using e-mail, a textual notification message may be contained in the body of the e-mail, and/or a file containing a digitized notification message may be attached to the e-mail for playback using an appropriate application already resident on the Internet user's computer 14.

The selected notification message is appropriately formatted by the textual or audible message recorder/IP formatter module 30. The formatter module 30 may include a plurality of pre-recorded audible and/or textual notification messages for the caller to choose from, or may allow the caller to record and digitize a personalized audible message.

The formatter module 30 also formats the selected notification message into an appropriate form for the ISP's particular mode of communication. For instance, if e-mail is the form of communication used by the particular ISP, then the formatter module 30 formats an appropriate e-mail message together with an attached ".wav" or other digitized audio file if necessary, and sends it to the appropriate e-mail address on file for the particular Internet user.

The e-mail address may be maintained in an appropriate table for access by the formatter module 30.

In operation, a caller using the telephone 32 may unsuccessfully attempt to call the telephone 12 of the Internet user. Either knowing the propensity of the attempted called party, or after being informed of likely Internet usage by the central office by the called Internet user, the caller can hang up, and then place another telephone call to a specially designated, predetermined telephone number (e.g., in a modem bank 26) at the ISP 109. Upon appropriate prompting initiated by the Internet communication module 28, the caller at telephone 32 would input a unique identifying number for the Internet user, e.g., a telephone number used in this case as a special designate for the Internet user. The caller may also be provided with the opportunity to select or record a particular notification message.

In response, the formatter module 30 selects and formats the appropriate notification message, and sends it to the Internet user over the data communication line established between the Internet user and the ISP 109.

Conclusion

Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the

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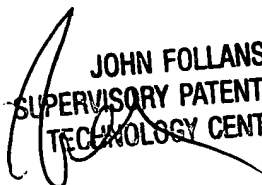
claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok B. Patel whose telephone number is (571) 272-3972. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Abp


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